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means, recorded on the recording medium, for assigning, in response to user input through the user interface, a new context value to the context; and

means, recorded on the recording medium, for repeating, in response to user input from the user interface, the steps of assigning a new context value to the context, inferring a context table name and a context field name, selecting records, and downloading selected records.

18. (Original) The computer program product of claim 13 further comprising means, recorded on the recording medium, for selecting a display form in dependence upon the shortcut value, wherein means, recorded on the recording medium, for displaying selected records through the user interface on the client device further comprises means, recorded on the recording medium, for downloading the selected records to the client device for display in the display form.

#### REMARKS

Claims 1-18 stand rejected for obviousness under 35 U.S.C § 103(a) as being unpatentable over Johnson (U.S. Patent No. 6,738,768) in view of Dickman, *et al.* (U.S. Patent No. 6,091,409). As will be shown below, neither Johnson nor Dickman, either alone or in combination, teaches or suggests a method, system, or computer program product for a context aware, shortcut enabled method of presenting information through a user interface on a client device as claimed in the present application. Claims 1-18 are therefore patentable and should be allowed. Applicants respectfully traverse each rejection individually and request reconsideration of claims 1-18.

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Claim Rejections – 35 U.S.C. § 103

Claims 1-18 stand rejected under 35 U.S.C § 103(a) as unpatentable over Johnson (U.S. Patent No. 6,738,768) in view of Dickman, *et al.* (U.S. Patent No. 6,091,409). Applicants respectfully traverse each rejection. To establish a prima facie case of obviousness, three basic criteria must be met.<sup>1</sup> First, the combination must teach or suggest all of Applicants' claim limitations.<sup>2</sup> Second, there must be a suggestion or motivation to combine the references.<sup>3</sup> Finally, there must be a reasonable expectation of success in the combination.<sup>4</sup>

Johnson and Dickman

Claims 1-18 stand rejected under 35 U.S.C § 103(a) as unpatentable over Johnson (U.S. Patent No. 6,738,768) in view of Dickman, *et al.* (U.S. Patent No. 6,091,409). The combination of Johnson and Dickman cannot establish a prima facie case of obviousness because the proposed combination does not teach each and every element of claims 1-18, there is no suggestion or motivation to make the proposed combination, and there is no reasonable expectation of success in the proposed combination.

The combination Of Johnson and DickmanDoes Not Teach all Of Applicants' Claim Limitation

The combination of Johnson and Dickson does not teach or suggest all of Applicants' claim limitations. The present application is entitled "Shortcut Enabled, Context Aware Information Management." Independent claim 1 claims:

A context aware, shortcut enabled method of presenting information through a user interface on a client device, the method comprising the steps of:

<sup>1</sup> Manual of Patent Examining Procedure §2142.

<sup>2</sup> *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974).

<sup>3</sup> *In re Vaack*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991).

<sup>4</sup> *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986).

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selecting a context;

receiving a shortcut entered through the user interface, the shortcut having a associated with it a shortcut field name set comprising one or more shortcut field names;

inferring from a context definition table, in dependence upon the context, a context table name and a context field name;

selecting information records from an information database in dependence upon the context, the context table name, the shortcut field names, and the context field name; and

displaying selected records through the user interface on the client device.

The following discussion considers each element of claim 1 in sequence:

Johnson and Dickman Do Not Teach or Suggest Selecting a Context

The Office Action states that Dickman teaches "select a context (see fig.7, item 64 and fig. 8, item 68, column. 7, lines 1-41)." Applicants in response respectfully note that figure 7, item 64, in Dickman is a depiction of a pull-down menu item labeled "Create Shortcut," obviously having nothing at all to do with selecting a context according to the claims of the present application. In addition, figure 8, item 68, in Dickman is a depiction of a pull-down menu item labeled "View Source," again, obviously having nothing at all to do with selecting a context according to the claims of the present application. Moreover, Dickman in the paragraphs at column 7, lines 1-41, is obviously, first, a description of a process for creating a shortcut to an Internet document (column 7, lines 1-3) and, second, a description of a "'Favorites' folder which may be used for holding Internet shortcuts to favorite Internet sites of a user," a process that obviously has

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absolutely nothing to do with selecting a context according to the claims of the present application (column 7, lines 12-14). There is not one word or one image in these cited figures and paragraphs of Dickman that teaches or suggests in any way selecting a context within the meaning of the claims in the present application. Dickman at figure 7 item 64, figure 8, item 68, and column 7, lines 1-41 cannot be said to teach or suggest selecting a context within the meaning of the claims in the present application.

Johnson And Dickman Do Not Teach Or Suggest Receiving A Shortcut Entered Through The User Interface, The Shortcut Having Associated With It A Shortcut Field Name Set Comprising One Or More Shortcut Field Names

The Office Action states that Johnson teaches "receiving a shortcut entered through the user interface, the shortcut having associated with it a shortcut field name set comprising one or more shortcut field names (user interface context where the user would select or receive the option of creating of shortcuts on his/her own desktop and each shortcut has field to be entered to name that shortcut: column. 5, lines 48-67 and column. 6, lines 1-28 ... ." Applicants respectfully propose in response, however, that Johnson at column 5, lines 48-67 and column 6, lines 1-28, is a discussion of redundancy avoidance in information capture actions ("ICAs") that has nothing whatsoever to do with receiving shortcuts having associated field name sets. Johnson at column 5, lines 51-52 states that a particular ICA is "only redundant when a web page is visited that was previously visited ..." In addition, Johnson at column 6, lines 20-23 states, "The superset option says to treat a shortcut copy action (an ICA) as redundant when it is a superset of previously performed shortcut copy action (ICA of same time)." That is, this cited section of Johnson is concerned with ICA redundancy and discloses nothing about receiving shortcuts having associated field name sets according to the claims of the present application.

Moreover, the references to shortcuts in this section of Johnson are references to traditional shortcuts for invoking executables or hyperlinks. In fact, the specific example in Johnson at column 6, line 23 is a shortcut to a URL, "http://www.domain.com/path1."

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That is, these references in Johnson, column 5, lines 48-67 and column 6, lines 1-28, teach and suggest nothing at all regarding shortcuts according to the present application that bear associated field name sets in dependence upon which context data is inferred and information records for display are selected. Johnson at column 5, lines 48-67 and column 6, lines 1-28 cannot be said to teach or suggest receiving a shortcut entered through the user interface, the shortcut having associated with it a shortcut field name set comprising one or more shortcut field names, as claimed in the present case.

Johnson And Dickman Do Not Teach Or Suggest Inferring From A  
Context Definition Table A Context Table Name And A Context Field Name

The Office Action states that Johnson teaches "inferring from a context definition table, in dependence upon the context, a context table name and a context field name (the pulldown option having a list of text option to be selected from the user in order to get the desired operation: column. 4, lines 50-60)." Applicants in response respectfully propose that Johnson at column. 4, lines 50-60 is a discussion of a traditional GUI pulldown menu for an ICA configuration window that has nothing at all to do with inferring context data according to the claims of the present application. In fact, Johnson states explicitly at column. 4, lines 56-57 that the cited pulldown feature is old: "Pulldowns are as is conventional in a windowed system." There is not one word in this cited section of Johnson that teaches or suggests in any way inferring from a context definition table, in dependence upon the context, a context table name and a context field name, within the meaning of the claims in the present application. Johnson at column 4, lines 50-60 cannot be said to teach or suggest inferring from a context definition table, in dependence upon the context, a context table name and a context field name, within the meaning of the claims in the present application.

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Johnson And Dickman Do Not Teach Or Suggest Selecting Information  
Records From An Information Database In Dependence Upon The Context,  
The Context Table Name, The Shortcut Field Names, And The Context Field Name

The Office Action states that Johnson teaches “selecting information records from an information database in dependence upon the context, the context table name, the shortcut field names, and the context field name (a data record containing at least one field to be created for the shortcut: see fig. 2 and fig. 6, column. 7, lines 1-25 and column. 12, lines 1-38).” Applicants in response respectfully propose that in fact Johnson at figure 2 and column 7, lines 1-25 is a discussion of a data structure called a “redundance determination history information data record” for use in detecting ICA redundancy according to Johnson – that has nothing at all to do with selecting information records from an information database in dependence upon context, context table name, shortcut field names, and context field names according to the claims of the present application. Similarly, Johnson at figure 6 and column 12, lines 1-38 is a discussion of a flowcharted method for “describing a preferred embodiment of the information capture action redundancy determination processing aspects of the present application for information capture actions that do not utilize bounds descriptor information” – also having nothing at all to do with selecting information records from an information database in dependence upon context, context table name, shortcut field names, and context field names according to the claims of the present application. There is not one word in these cited sections of Johnson that teaches or suggests in any way selecting information records from an information database in dependence upon context, context table name, shortcut field names, and context field name within the meaning of the claims in the present application. Johnson at figure 2, figure 6, column 7, lines 1-25, and column 12, lines 1-38 cannot be said to teach or suggest selecting information records from an information database in dependence upon context, context table name, shortcut field names, and context field name within the meaning of the claims in the present application.

Johnson And Dickman Do Not Teach Or Suggest Displaying  
Selected Records Through The User Interface On The Client Device

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The Office Action states that Dickman teaches "input/output devices including a video display displaying the location information of an encapsulated object as a visual representation of the object at a location that lies outside of the window (column. 4, lines 64-67, column. 5, lines 1-22 and column. 6, lines 38-48)." Applicants note, however, that displaying selected records through the user interface on the client device according to claim 1 of the present application is displaying records selected on the basis of context data as claimed in claim 1 of the present application. Applicants respectfully propose further that the paragraph of Dickman between column, 4 lines 64 and column 5, line 22 is a discussion of Figure 3 of Dickman, a generic description of a generic computer system that clearly has absolutely nothing at all to do with displaying selected records through the user interface on the client device according to the claims of the present application. Applicants further note respectfully that Dickman at column 6, lines 38-48 is a discussion of "how Internet shortcuts appear and how they are used by a user" on an ordinary browser – clearly having absolutely nothing at all to do with displaying selected records through the user interface on the client device according to the claims of the present application. There is not one word in these cited sections of Dickman, nor is there anything elsewhere in Dickman, that teaches or suggests in any way displaying selected records through the user interface on the client device within the meaning of the claims in the present application. Dickman at column 4, lines 64-67, column 5, lines 1-22, and column 6, lines 38-48 cannot be said to teach or suggest displaying selected records through the user interface on the client device within the meaning of the claims in the present application.

#### No Suggestion or Motivation to Modify Johnson

To establish a prima facie case of obviousness, there must be a suggestion or motivation to modify Johnson. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The suggestion or motivation to modify Johnson must come from the teaching of Johnson itself, and the Examiner must explicitly point to the teaching within Johnson suggesting the proposed modification. Absent such a showing, the Examiner has

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impermissibly used "hindsight" occasioned by Applicants' own teaching to reject the claims. *In re Surko*, 11 F.3d 887, 42 U.S.P.Q.2d 1476 (Fed. Cir. 1997); *In re Vaeck*, 947 F.2d 488m 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re Gorman*, 933 F.2d 982, 986, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991); *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 871 F.2d 115, 117, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989).

The Office Action at page 5 states its rationale for motivation to combine as:

The motivation being to have a system having GUI for user to locate information on the web pages context and also creating shortcuts for those web pages on the visual desktop via create shortcut menu and let user is enabled to click a right button on the mouse to cause a context of menu to be displayed an the client computer. (sic)

This description apparently is taken from paragraph in Dickman beginning at column 7, line 1:

Once the Internet document is displayed within the client area of the "Internet Explorer" window 58, the user has a number of options for creating a shortcut to the document. First, the user may open a file menu 62 that includes a "Create Shortcut" menu option 64 which when selected causes a shortcut for the active Internet document to be created on the virtual desktop 50. Another option to create a shortcut is for the user to click a right button on the mouse 46 to cause a context menu 68 to be displayed for the Internet document. The context menu 68 includes a menu option 70 for creating a shortcut.

The 'context menus' of Dickman are conventional context-sensitive help menus already described in Johnson at column 5, line 1:



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User invocation of the <F1> key over a particular area on the window will provide context sensitive help to the particular area, as is implemented by many conventional user interfaces.

The suggestion to modify Johnson must come from a teaching within Johnson, not from Dickman. In addition, it is clear that Johnson would never be concerned to modify its disclosures with elements already known to Johnson and already described within Johnson as "implemented by many conventional user interfaces." The Examiner must point to teaching within Johnson suggesting selecting a context and displaying records selected in dependence upon the context. It is not possible to find such a teaching in Johnson because Johnson is concerned with prevention of information capture redundancy, not with selection and display of information records according to context within the meaning of the claims of the present application. Absent such a showing, the Examiner has impermissibly used hindsight occasioned by Applicants' own teaching to reject the claims. The Examiner has not pointed to any disclosure in Johnson suggesting selection and display of information records according to context within the meaning of the claims of the present application. As such, the proposed modification of Johnson cannot establish a prima facie case of obviousness.

Johnson Teaches Away From Selecting A Context And  
Displaying Records Selected In Dependence Upon The Context

Turning now to the substance of Johnson, Johnson actually teaches away from selecting a context and displaying records selected in dependence upon the context. Teaching away from the claims is a *per se* demonstration of lack of prima facie obviousness. *In re Dow Chemical Co.*, 837 F.2d 469, 5 U.S.P.Q.2d 1529 (Fed. Cir. 1988); *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); *In re Neilson*, 816 F.2d 1567, 2 U.S.P.Q.2d 1525 (Fed. Cir. 1987). Johnson uses the term 'context' to refer to cyberspace location information for web pages, documents, and files. In Johnson, the 'context' of an 'information capture action' or 'ICA' is the location of the subject data to be captured. The location is expressed as a URL, a pathname for a file on a file system, or some other

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description of location. The clearest explanation of 'context' in Johnson is at column 7, line 7, where Johnson describes the data element (reference 204 on Figure 2 of Johnson) for the 'context' of an ICA (emphasis added):

A reference field 204 contains the ICA reference. ICA references include, and are not limited to, fully qualified web page addresses, fully qualified web site file repositories, fully qualified document location (e.g. File Transfer Protocol (FTP) address), fully qualified system file path name, or some other unique contextual information describing the ICA for the ICA type.

All uses of the term 'context' in Johnson are consistent with this definition:

For example, Johnson at column 10, line 46, states (emphasis added):

Block 506 performs the ICA by transposing to the user interface context (e.g. web page address transposition).

For a further example, Johnson at column 11, line 34 states (emphasis added):

Block 518 determines the clipboard ICA and then block 520 accesses the bounds parameters of the clip which have already been specified, for example, all of a context (e.g. entire document or web page), the offset and length into a selection (e.g. html file), or the like.

For a still further example, Johnson at column 13, line 47 states (emphasis added):

Thereafter, block 508 prunes RDHI according to ICA configurations, and block 510 inserts (if collect history setting 132 enabled) a RDHI data record 200 to the RDHI with the ICA type field 202 set appropriately (e.g. print or clip), reference field 204 set appropriately (e.g. fully qualified document path name if a document to print, fully qualified user interface

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context (e.g. web page address) if a print, etc., or fully qualified user interface context (e.g. web page address) if a clip), bounds descriptor field 206 set to any applicable bounds information, and date/time stamp field 208 set to the current system date/time.

A 'context' as claimed in the present application is a data element in dependence upon which information records are selected for display from an information database. The 'contexts' of Johnson are never used to select information for display. On the contrary, the 'contexts' of Johnson are used to prevent redundant display of information whose location in cyberspace is identified by Johnson's 'contexts.' In disclosing 'contexts' as locations of information used to prevent redundant capture or display, Johnson teaches directly away from a 'context' as claimed in the present application. Because Johnson teaches away from selecting a context and displaying records selected in dependence upon the context as claimed in the present application, the proposed modification of Johnson by Dickman cannot support a prima facie case of obviousness.

#### No Reasonable Expectation of Success

To establish a prima facie case of obviousness, there must be a reasonable expectation of success in the proposed modification of Johnson. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). There can be no reasonable expectation of success in a proposed modification if the proposed modification changes the principle of operation of Johnson. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). Johnson teaches a 'context' as a cyberspace location information for web pages, documents, and files. A 'context' in Johnson is any location of any web page, document, or file that is subject to access through an 'information capture action' or 'ICA.' A context in Dickman, however, is merely the context for a lookup in a context-sensitive help function, well known as prior art to both Johnson and Dickman. The principle of operation of Johnson, contexts as locations of information subject to ICAs, obviously is changed completely, and in fact will not function at all, with the addition of contexts as

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bases of context-sensitive help functions from Dickman. The proposed modification of Johnson by Dickman therefore cannot possibly support a prima facie case of obviousness.

Conclusion

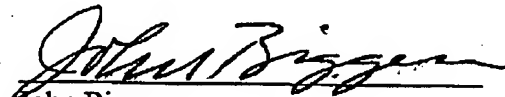
Claims 1-18 stand rejected for obviousness under 35 U.S.C § 103(a) as being unpatentable over Johnson (U.S. Patent No. 6,738,768) in view of Dickman, *et al.* (U.S. Patent No. 6,091,409). For the reasons set forth above, however, the proposed modification of Johnson in view of Dickman fails to establish a prima facie case of obviousness. The rejection of claims 1-18 should therefore be withdrawn, and the claims should be allowed. Reconsideration of claims 1-18 in light of the present remarks is respectfully requested.

The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447 for any fees required or overpaid.

Respectfully submitted,

Date: 8.24.04

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